

Application No. 10/719,795  
Reply to Office Action of August 30, 2006

Docket No.: HO-P02901US1

### REMARKS

The claims pending in this application are 1 and 3 – 13. Claim 2 has been canceled in a prior amendment.

Claims 1, 7 and 10 have been amended to require that the crumb rubber be untreated.

No other amendments have been made.

### THE §102(e) REJECTION

The Examiner has rejected the pending claims under 35 USC §102(e) as anticipated by Cart. Applicant respectfully submits that the claims as amended are to anticipated by Cart and are in condition for allowance.

To anticipate a claim under 35 U.S.C. §102, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. §102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. §2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The 35 U.S.C. §102 rejection of record fails to establish a 35 U.S.C. §102 rejection in accordance with the foregoing requirements.

Cart discloses the use of crumb rubber particles in drilling fluids however, Cart requires that the crumb rubber particle be treated to render the particle oil and water wettable. See Col 4:14 – 21.

This is in contrast to the present invention where the crumb rubber particles are used without further treatment. As shown in the examples of the present disclosure, the crumb rubber particle are added directly to the drilling fluid without the need of surfactants or other surface treatments. These untreated particles are effective at previously fluid loss. See paragraphs 0043 and 0045.

Cart’s failure to teach the limitation that the crumb rubber be untreated prevents Cart from anticipating the claims as amended.

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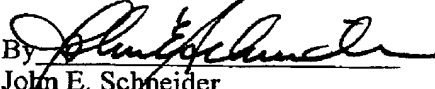
**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02901US1 from which the undersigned is authorized to draw.

Dated: October 9, 2006

Respectfully submitted,

By   
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,795	11/21/2003	Robert R. Wood	HO-P02901US1	2945
26271	7590	08/30/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			ZIMMER, MARC S	
1301 MCKINNEY			ART UNIT	
SUITE 5100			PAPER NUMBER	
HOUSTON, TX 77010-3095			1712	

DATE MAILED: 08/30/2006

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OCT 09 2006

Please find below and/or attached an Office communication concerning this application or proceeding.

FULBRIGHT & JAWORSKI, LLP  
 IPT DOCKETING  
 Docketed ☒ Not Req'd ☐ Confirmation ☐  
 Initials 1st JM Initials 2nd RAB  
 SEP 07 2006  
 Attorney JES - PVER INT.  
 Docket No. P02901US1  
 Action Req'd  
 Respond to  
 OA  
 Date Due  
 11/30/2006

**Office Action Summary****Application No.**

10/719,795

**Applicant(s)**

WOOD, ROBERT R.

**Examiner**

Marc S. Zimmer

**Art Unit**

1712

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### ***Claim Analysis***

In the Examiner's last correspondence, it had been noted that the claims refer to an essential component of their invention in terms of a particle size, there being no indication as to whether the range is actually suggestive that all particles adhere to this limitation or, instead, the range alludes to an *average* particle size. The Examiner had stated that, for the purpose of evaluating the claims against the prior art, it would be presumed that all of the crumb rubber particles must have a particle size of 400 to 4000. It is now appreciated, however, that the Examiner had not given this term its broadest possible meaning and, in fact, it would be completely appropriate to infer from Applicant's disclosure that the particle range reported is an average particle range/diameter as this is the convention used almost ubiquitously when disclosing a parameter of a particulate substance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Cart,  
U.S. Patent # 6,806,232.

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Cart discloses the formulation of aqueous or oil-based (column 4, lines 33-36) drilling fluids containing crumb rubber having a particle size of between 0.4 and 2,000 microns (column 4, lines 3-13). Relevant to claim 5, there is mention in column 4, lines 42-43 of the employment of a cellulosic as a fluid-loss control agent and, although it is acknowledged that this is within the context of describing an aqueous-based mud, the reference further mentions in column 5, lines 1-5 that a hydrocarbon component may be introduced into the water-based fluids of their invention.

Concerning claims 3, 6, 8, and 9, these limitations are all inherently satisfied inasmuch as Cart teaches the same source of rubber particulate..

Relevant to claim 10, the drilling fluids injected into the well to prevent mud loss comprise between 1 and 100 pounds of crumb rubber per barrell of the fluid according to column 4, lines 64-67.

In the last Office action, claims 1-13 had been rejected under 35 U.S.C. 102(b). This rejection was in error only because the reference was actually a reference under 35 U.S.C. 102(e), the reference having published only about 9 months prior to the effective filing date of this application. Insofar as paragraph (e) requires that the invention described by a reference be one that is invented "by another", U.S. 6,518,224 doesn't qualify as prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 24, 2006

*Marc S. Zimmer*  
MARCS. ZIMMER  
PRIMARY EXAMINER

<b>Notice of References Cited</b>	Application/Control No. 10/719,795	Applicant(s)/Patent Under Reexamination WOOD, ROBERT R.	
	Examiner Marc S. Zimmer	Art Unit 1712	Page 1 of 1

## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,806,232	10-2004	Cart, Steve	507/118
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office  
 PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20060824